UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,040	04/02/2004	Jordan L.K. Schwartz	MSFT122099	2243

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EXAMINER
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ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
	10/817,040	SCHWARTZ ET AL.
Office Action Summary	Examiner	Art Unit	
	Phenuel S. Salomon	2109	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>4/2/04</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 April 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the original filing of April 02, 2004. Claims 1-21 are

pending and have been considered below.

Claim Objections

2.   Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. The Office

considers any claim, which refers to another claim as being a dependent claim. Claim

20 refers to Claim 1 and, thus, is considered to depend thereon. However, Claim 1 is a

method claim, which consists of the steps of sensing the presence of an indicator, and

rendering a view. Claim 20 does not include any limitations, which add, delete or

change any of these steps. Therefore, Claim 20 fails to further limit its parent claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form.

3.   Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. The Office

considers any claim, which refers to another claim as being a dependent claim. Claim

21 refers to Claim 12 and, thus, is considered to depend thereon. However, Claim 12 is

a method claim, which consists of the steps of pre-caching and displaying a thumbnail...

Claim 21 does not include any limitations, which add, delete or change any of these

steps. Therefore, Claim 21 fails to further limit its parent claim. Applicant is required to

cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent

form, or rewrite the claim(s) in independent form.

Specification

4.   The disclosure is objected to because of the following informalities: for example,

the examiner notes on page 8, lines 6 and 14: "...As is illustrated in Figure...."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b)
that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

6.   Claims 1, 11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Smith (US 5,721,853).

Claim 1: Smith discloses a method, comprising:

        sensing the presence of an indicator in a vicinity of an icon having associated

thumbnail data (col. 4, lines 45-51); and

        rendering a view of at least a portion of the thumbnail data, the view rendered in

the vicinity of the icon (col. 4, lines 58-67).

Claim 11: <u>Smith</u> discloses a method according to claim 1 above, wherein the view
rendered is rendered within a window displayed in a graphical user interface (see fig. 2).

Claim 20: <u>Smith</u> discloses a computer-readable medium having code segments
embodied thereon that cause a machine to perform the method according to claim 1
(see fig. 1).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 2-10,12-16, 17-19 and 21 are rejected under U.S.C. 103(a) as being
unpatentable over <u>Smith</u> (US 5,721,853).

Claim 2: <u>Smith</u> discloses a method as in claim 1 above, but does not explicitly disclose
that pre-caching thumbnail data associated with at least one icon. However, <u>Smith</u> does
disclose a user interface navigational metaphor that is always available to the user (col.
2, lines 46-47). Therefore, it would have been obvious to one having ordinary skill in the
art at the time of the invention to use pre-caching data associated with an icon. One
would have been motivated to do so in order to provide maximum functionality in a
minimum time span.

Claim 3 & 14: <u>Smith</u> discloses a method as in claim 2 above and claim13 below, but
does not explicitly disclose that pre-caching the thumbnail data includes storing the
thumbnail data in volatile memory. However, <u>Smith</u> does disclose a computer system

with a memory device (fig. 1). Therefore, it would have been obvious to one having
ordinary skill in the art at the time of the invention to store the thumbnail data in volatile
memory. One would have been motivated to do so in order to have a faster execution of
the associated program.

Claim 4: Smith discloses a method as in claim 2 above, but does not explicitly disclose
that rendering includes retrieving the pre-cached thumbnail data associated with the
icon. However, Smith does disclose moving the pointer into the area defined by GDE
will cause the collar to be displayed (col. 4, lines 49-51). Therefore, it would have been
obvious to one having ordinary skill in the art at the time of the invention to use pre-
caching data associated with the icon. One would have been motivated to do so in order
to provide quicker visual representation of the icon as well as the functionality
accessible therewith.

Claim 5: Smith discloses a method as in claim 4 above, but does not explicitly disclose
rendering of the view occurs substantially immediately after sensing the indicator.
However, Smith does disclose an icon being displayed immediately after hovering a
mouse pointer over GDE (fig. 2 & 3a). Therefore, it would have been obvious to one
having ordinary skill in the art at the time of the invention to render a view immediately
after sensing the indicator. One would have been motivated to do so in order to inform
the user about the icon and the associated program.

Claim 6: Smith discloses a method as in claim 2 above, but does not explicitly disclose
thumbnail data associated with a plurality of icons are pre-cached. However, Smith
does disclose movement of the mouse pointer into the quadrant labeled "Tool Bar"
results in the display of a secondary interface (fig 3a). Therefore, it would have been
obvious to one having ordinary skill in the art at the time of the invention to use pre-
caching data associated with a plurality of icons. One would have been motivated to do
so in order to provide quicker visual representation of the icons as well as the
functionality accessible therewith.

Claim 7: <u>Smith</u> discloses a method as in claim 6 above, but does not explicitly disclose number of icons that include thumbnail data being pre-cached is a predetermined number of icons. However; <u>Smith</u> does disclose a plurality of icons being displayed (fig. 3a). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have a predetermined number of icons being pre-cached. One would have been motivated to do so in order to quickly inform the user about the available resources on the system.

Claim 8: <u>Smith</u> discloses a method as in claim 7 above, but does not explicitly disclose the predetermined number of icons is a predetermined number of icons located in an area situated in the region of the icon the indicator is in the vicinity of. However; <u>Smith</u> does disclose a plurality of icons being displayed in the vicinity of the mouse pointer (fig. 3a). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have a predetermined number of icons located in the area close to the indicator. One would have been motivated to do so in order to help the user quickly access the available resources.

Claim 9: <u>Smith</u> discloses a method as in claim 8 above, but does not explicitly disclose predetermined number of icons is greater than one icon and less than a total number of icons viewable within an environment the icon is displayed in. However; <u>Smith</u> does disclose a plurality of icons being displayed are greater than one icon (fig. 3a). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have a predetermined number of icons that is greater than one. One would have been motivated to do so in order to emphasize on the amount of available resources.

Claim 10: <u>Smith</u> discloses a method as in claim 7 above, but does not explicitly disclose predetermined number of icons is the number of icons having associated thumbnail data viewable within an environment the icon is displayed in. However; <u>Smith</u> does

disclose a plurality of icons being displayed with associated data (fig. 3a, item 302d).
Therefore, it would have been obvious to one having ordinary skill in the art at the time
of the invention to have a predetermined number of icons having associated thumbnail
data. One would have been motivated to do so in order to let the user quickly identify
the icon and the resources associated therewith.

Claim 12: Smith discloses a method, but does not explicitly disclose pre-caching
thumbnail data associated with at least one icon displayed in a viewable interface.
However; Smith does disclose displaying thumbnail data associated with the at least
one icon when an indicator is hovered substantially over the at least one icon (col. 5,
lines 4-6 & fig. 3a). Therefore, it would have been obvious to one having ordinary skill in
the art at the time of the invention to use pre-caching data associated with an icon. One
would have been motivated to do so in order to provide maximum functionality in a
minimum time span.

Claim 13: Smith discloses a method as in claim 12 above, but does not explicitly
disclose "pre-caching that includes pre-caching thumbnail data associated with at least
a plurality of icons, the pre-cached...". However, Smith does disclose an icon being
displayed immediately after hovering a mouse pointer over GDE (fig. 2 & 3a). Therefore,
it would have been obvious to one having ordinary skill in the art at the time of the
invention to render a view immediately after sensing the indicator. One would have
been motivated to do so in order to provide quicker visual representation of the icons as
well as to inform the user about the icon and the associated program therewith.

Claim 15: Smith discloses a method as in claim 13 above, but does not explicitly
disclose only thumbnail data for icons currently displayed in an operating environment
are pre-cached. However; Smith does disclose a plurality of icons being displayed (fig.
3a, item 302d). Therefore, it would have been obvious to one having ordinary skill in the
art at the time of the invention to pre-cache data for icons currently displayed in an

operating environment. One would have been motivated to do so in order to provide quicker visual representation and efficient use of volatile memory.

Claim 16: <u>Smith</u> discloses a method as in claim 13 above, but does not explicitly disclose only thumbnail data for a predetermined number of icons are pre-cached. However; <u>Smith</u> does disclose a plurality of icons being displayed (fig. 3a). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have a predetermined number of icons being pre-cached. One would have been motivated to do so in order to quickly inform the user about the available resources on the system.

Claim 21: <u>Smith</u> discloses a computer-readable medium as in claim 12 above, but does not explicitly disclose a computer readable medium having code segments embodied thereon that cause a machine to perform the method of claim 12. However; <u>Smith</u> does disclose a computer-readable medium (shown in fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use the code segment. One would have been motivated to do so in order to provide maximum functionality of the system to carry out the particular invention.

Claim 17: <u>Smith</u> discloses a system, but does not explicitly disclose an arrangement for pre-caching thumbnail data associated with at least one icon, the arrangement further for displaying the pre-cached thumbnail data associated with the at least one icon when an indicator is hovered substantially over the at least one icon. However; <u>Smith</u> does disclose a mouse pointer when moved over the spot GDE, causes a collar to display (col. 4, lines 45-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to pre-cache data associated with an icon. One would have been motivated to do so in order to provide a faster rendering of the icon visual representation of the available resources.

Claim 18: <u>Smith</u> discloses a system as in claim 17 above, but does not explicitly disclose arrangement that includes a volatile memory for pre-caching the thumbnail data. However; <u>Smith</u> does disclose display device and memory (fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have an arrangement of volatile memory for pre-caching the thumbnail data. One would have been motivated to do so in order to have a faster rendering of the icons.

Claim 19: <u>Smith</u> discloses a system as in claim 18 above, and <u>Smith</u> further discloses a computer system in (fig. 1).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. <u>Gargi</u> (US 6,915,489 B2) discloses image browsing using cursor positioning.

b. <u>Kobayashi</u> et al. (US 6,938,215 B2) discloses display apparatus and methods, and recording medium for controlling same.

c. <u>Jaaskelainen, Jr.</u> (US 5,835,088) discloses method and apparatus for providing programmable window-to-window focus change within a data processing system using GUI.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phenuel S. Salomon whose telephone number is (571)
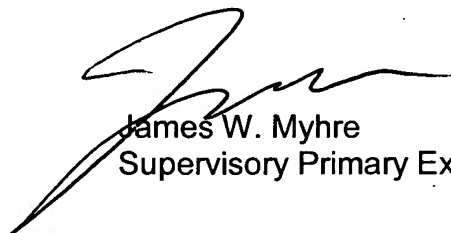
270-1699. The examiner can normally be reached on Mon-Fri 7:00 A.M. to 4:00

P.M.(Alternate Friday Off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Myhre can be reached on (571) 270-1065. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-3800.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSS
1/26/2007

James W. Myhre
Supervisory Primary Examiner